

consideration by the Applicant and, in view of those comments, Applicant submits the foregoing amendments as placing the claims in condition for allowance and requests favorable consideration of the amended claims.

Claim 14 was objected to because the Examiner argued that it did not further limit the subject matter as recited in claim 1. The Examiner stated that Applicant should either cancel claim 14, or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 14 recites the limitation that the flange fastener is positioned into a predetermined aperture in said groove and into a predetermined aperture in said flange depending upon the choice of lighting reflector and the light bulb. The specific aperture into which the fastener is positioned is not recited in claim 1. While claim 1 recites a plurality of apertures are formed in the sidewall groove of the mounting member, there is nothing in claim 1 which recites which aperture is used to secure the mounting plate. Thus Applicant submits that claim 14 contains language which further limits the scope of the invention as claimed in claim 1, and as such is dependent on claim 1.

Turning now to the rejected claims, claims 1-9, 11, and 15-16 were rejected under 35 USC 103(a) based on US 5,791,768 to Splane. According to the Examiner, in regard to claims 1-4, 7, 9, and 11, Splane discloses an adjusting member 18 with two ends with one end adjacent to a lamp socket 16, two grooves located approximately opposite to each other 19 and extending between the two ends of the adjusting member 18, two flange members 22 which are slideably engaged within each groove 16 extending perpendicularly from the groove, where the flange thickness is shown to approximately equal to the groove depth and the groove width is naturally larger than the flange width, and engaged with an adjusting ring 23 which has a central aperture for accommodating the adjusting member 18 and an aperture for fastening the adjusting ring to the adjusting member and fastens the reflector in place, and a casing 12 which is inherently an endplate which is detachably connected to the adjusting member 18 on one side via a screw 20. While conceding that Splane fails to teach a plurality of apertures formed within the grooves and at least one aperture formed within the flange members 21, 21, the Examiner concludes that it would generally be obvious

to one of ordinary skill in the art to have a plurality of apertures within the groove to secure flange rod 21 within the groove of the adjusting member 18 at predetermined intervals using a fastener introduced through flange member to the groove aperture. Therefore, according to the Examiner, it would be obvious to one of ordinary skill in the art to have the flange rod components of Splane with a plurality of holes engaging with a plurality of holes disposed within the grooves of the adjusting member 18.

Furthermore, with respect to claims 15-16, the Examiner argues that Splane discloses a structure that would be obvious to one of ordinary skill to perform the method claimed for the same reasons set forth above for claims 1-4, 7, 9, and 11.

With respect to claims 5, 6, and 8, the Examiner argued that it would be generally obvious to one of ordinary skill to make the pair of flange rod elements 46 relatively opposite to each other in Fig. of Splane integral with the adjusting ring 47, which would reduce the number of parts required for assembly. Furthermore, it would have been obvious to make them integral because it has been held to be within the general skill of a worker in

the art to make plural parts unitary as a matter of engineering design choice. Therefore, it would be obvious to integrate the flange members with the adjusting ring and forming a plurality of apertures on the flange and groove for setting the position of the mounting member relative to the reflector at predetermined intervals.

The Examiner objected to claims 10, and 12-13, but stated that they would be allowable if rewritten in independent form, since the Examiner concluded with respect to claim 10 that the prior art does not teach a mounting plate with an aperture in the shape of a slot which extends to the center of mounting plate from periphery of mounting plate, and with respect to claims 12-13 that the prior art does not teach an adjustable reflector socket with specifically four apertures formed with the groove and two apertures formed with the flange member.

Turning now to Applicant's response to the Examiner's arguments, the suggested modifications to Splane '768 would not have been obvious to one of ordinary skill in the art for at least three reasons. First, to be held to be obvious, there must have been some teaching, motivation, or suggestion in the reference to make the modification. In

re Mills, 16 USPQ 2d 1430 (Fed. Cir. 1990). There is no such teaching, motivation, or suggestion in the reference. The Examiner has not demonstrated where in the reference any such teaching, motivation or suggestion exists. Therefore, absent such teaching in the reference, Applicant submits that the argument of obviousness is unsupported and should not be maintained.

Second, there is no reason to secure flange rods 21 within groove 19 of Splane '768 as concluded by the Examiner. The teachings of Splane '768 are perfectly clear in disclosing that there would be nothing gained by doing so. The reference teaches that the adjustment of Splane occurs by use of the screw threads located on the rotating ring 23. Since adjustment has already been provided for in Splane, the reference teaches against "adding" some other means of adjustment. In re Gordon, 221 USPQ 1125 (Fed. Cir. 1984). Thus, for this additional reason, the argument of the Examiner has been overcome.

Third, there is reason not to secure the flange rods of Splane '768 within grooves 19, based on the structure of the cited reference. The flanges of Splane slide across the top of the rotating ring as the ring is screwed about

the threaded adjusting member 18. By securing the flange rods to the ring, the sliding is precluded, and consequently, the adjustment feature of the reference is prevented as well. Since the modification argued by the Examiner would render the reference inoperable for its intended purpose, the modification would not be obvious. Hughes Aircraft Co. v. United States, 215 USPQ 787 (U.S. Ct. Cl. 1982). Therefore, for yet another reason, the obviousness argument of the Examiner has been overcome.

Furthermore, since Splane '768 does not disclose a structure that would render Applicant's invention as recited in claim 1 obvious to one of ordinary skill in the art, the method recited in claims cannot be obvious. With respect to claims 5-6, and 8, the Examiner argues it would be obvious to make the rod elements integral with the adjusting ring based on the embodiment of Splane shown in Fig. 3 of the reference. Applicant submits that such a modification would not be obvious.

The embodiment of Fig. 3 of Splane uses clamps to pull the ends of the ring together. The flange ends slide over the ring in the embodiment of Fig. 3, just as they do in the embodiment shown in Fig. 1. By securing the flanges to

the ring, arguably the clamping together of the two ends would be precluded, given the explicit teaching of Splane to have three pairs of grooves and flange members. Plus, if the thickness of the flange is approximately the same as the depth of the groove as argued by the Examiner on page 3 of the Office Action, any flexibility in the ring which might exist before the flanges would be secured to the ring, would be further reduced if not almost completely eliminated. Absent any flexibility in the ring, the two ends could not be clamped together as taught in the reference. Thus, for these additional reasons, the arguments of the Examiner with respect to claims 5-6, and 8 have been overcome.

The Examiner also cited four other patents as pertinent to Applicant's disclosure, however none was relied upon, and the additional Splane references suffer from the same problems as the one cited by the Examiner. Applicant concurs that Applicant's invention is neither anticipated nor obvious based on those references.

In view of the foregoing remarks, claims 1-16 are submitted for further consideration as being patentable. No amendment is being made with respect to the claims which

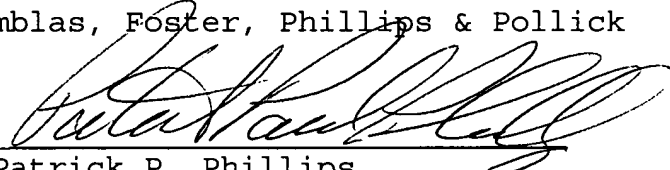
Ser. No. 10/656,958
Docket No. HYD 003 P2

were objected to, since Applicant submits that claim 1 is allowable. The allowance of all sixteen claims is thus respectfully solicited. If the Examiner has any questions which would expedite issuance of a Notice of Allowance, a telephone call to the undersigned is requested. The Commissioner is authorized to charge Deposit Account No. 13-3393 for any insufficient fees under 37 CFR §§ 1.16 or 1.17, or credit any overpayment of fees.

Respectfully submitted,

Kremblas, Foster, Phillips & Pollick

By


Patrick P. Phillips
Registration No. 29,690

7632 Slate Ridge Blvd.
Reynoldsburg, Ohio 43068
(614) 575-2100
(614) 575-2149 FAX
pphillips@ohiopatent.com
September 6, 2005